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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,523	12/12/2001	Yuichi Matsumoto	1232-4798	8524
27123 7590 01/15/2008 MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER TOPGYAL, GELEK W	
			ART UNIT 2621	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/021,523

Applicant(s)

MATSUMOTO ET AL.

Examiner

Gelek Topgyal

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/18/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/18/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/18/2007 have been fully considered but they are not persuasive.
2. In re pages 2-3, the applicants argue the fact that Saito fails to teach the claimed sending a "shifting history" which consists of a "list of buttons depressed by the cursor". The applicants suggest that Saito only teaches the ability to transmit a single command, and that a shifting history is not sent.
3. In response, the examiner respectfully disagrees. Saito does in fact teach the claimed limitation. The succession of each operation selected by the user (e.g. a user selects a "play" button from the displayed control panel, and a minute into the program, the user selects a "fast forward", "reverse", etc) has sent a history (more than one button selection) of where the cursor has been due to the ability of the system to highlight a particular button and via the selection of each button displayed on the control panel. The claimed limitation does not limit the invention to send the entire history of buttons that have been depressed by the communication unit in a single operation [emphasis added]. The limitations are met by the ability of Saito to send commands over successive commands and therefore have been broadly interpreted and rejected.

Furthermore, the "shifting history of buttons depressed" is not clearly defined as well. The limitations do not limit the system to have more than one button in the list. Therefore, Saito's teaching of being able to send a single command, can read on the claimed "shifting history" since a list can include a single command.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-12** are rejected under 35 U.S.C. 102(e) as being anticipated by Saito et al (US 6,523,696).

Regarding claim 1, Saito teaches a control device for remotely controlling a controlled device comprising:

a display unit which displays a control panel of the controlled device (third embodiment, col. 32-37, describes a system that displays a control panel of a secondary devices connected through a network. Figure 28 displays a list of the devices connected through a network. Figure 31 shows an example of a control panel of a networked device (DVD player) which meets the limitation of displaying a control panel); and

a communication unit for sending operation information to the controlled device, the operation information including a shifting history of a cursor (*As seen in Figures 5 and 7, the AV devices can be a TV, DVD or VTR, which are controlled by a remote control. Menus for controls on conventional remote controlled devices highlight (which*

reads on the claimed "cursor") a particular button so that the user knows which button is primed for selection by pressing an "enter" key) displayed on the control panel (third embodiment, col. 32-37 discloses that when a menu for a device (DVD Player, Fig. 31) is displayed, the user has the ability to select the any of the options available (Fig. 31, i201-i210), when selected by way of clicking on the buttons i201-i210 a corresponding command to the user's clicking is sent to the DVD player or VTR player. The command sent from by way of user selection by clicking on a choice i201-210 meets the limitation of sending operation information to the controlled device. The succession of each operation selected by the user as discussed above (e.g. a user selects a "play" button from the displayed control panel, and a minute into the program, the user selects a "fast forward", "reverse", etc) has sent a history of where the cursor has been due to the ability of the system to highlight a particular button (as discussed above) and via the selection of each button displayed on the control panel.)

wherein the shifting history represents a list of buttons depressed by the cursor
(As discussed above, the system of Saito et al. meets the claimed shifting history. Each user selection is a button that a user has highlighted (meeting claimed "cursor") and selected (meeting claimed "depressed")).

Regarding claim 2, Saito teaches that the control device is a TV (Col. 37, lines 3-15) and that the controlled device is a videocassette recorder (col. 34, lines 35-44).

Regarding claim 3, Saito teaches that similar to the VCR and the DVD player, the system has the ability to connect to a digital album server (col. 32, lines 25-32).

Regarding claims 4, 9 and 10, Saito teaches the claimed wherein the communication unit communicates with the controlled device via a serial bus conformed to IEEE 1394 protocol (Fig. 27, col. 32, lines 33-58, col. 32, lines 15-24).

Regarding claim 5, Saito teaches a controlled device controlled remotely by a control device comprising:

a communication unit sends a control panel of the controlled device to the control device (third embodiment, col. 32-37, describes a system where a first AV connection device 204, by way of a terminal (TV), sends a request to the second AV connection device 205 for a command list, in response to the request, the second AV connection device 205 transmits text linking the first AV connection device 204 to the control panel of a secondary devices connected to the secondary AV connection device 205 (VTR, DVD player). Figure 28 shows a list of the devices connected through a network. Figure 31 shows an example of a control panel of a networked device (DVD player) which meets the limitation of having sent the control panel to the control device (TV)); and receives operation information from the control device, the operation information including a shifting history of a cursor (*As seen in Figures 5 and 7, the AV devices can be a TV, DVD or VTR, which are controlled by a remote control. Menus for controls on conventional remote controlled devices highlight (which reads on the claimed "cursor") a particular button so that the user knows which button is primed for selection by pressing an "enter" key*) displayed on the control panel (third embodiment, col. 32-37 discloses that when a menu for a device (DVD Player, Fig. 31) is displayed, the user has the ability to select the any of the options available (Fig. 31, i201-i210), when selected by

way of clicking on the buttons i201-i210 a corresponding command to the user's clicking is sent to the DVD player or VTR player. The command sent from by way of user selection by clicking on a choice i201-210 meets the limitation of sending operation information to the controlled device. *The succession of each operation selected by the user as discussed above (e.g. a user selects a "play" button from the displayed control panel, and a minute into the program, the user selects a "fast forward", "reverse", etc) has sent a history of where the cursor has been due to the ability of the system to highlight a particular button (as discussed above) and via the selection of each button displayed on the control panel.); and*

a control unit which controls said controlled device using the operation information (third embodiment, col. 32-37 discloses that when a menu for a device (DVD Player, Fig. 31) is displayed, the user has the ability to select the any of the options available (Fig. 31, i201-i210), when selected by way of clicking on the buttons i201-i210 a corresponding command to the user's clicking is sent to the DVD player or VTR player. The command sent from by way of user selection by clicking on a choice i201-210 is received by the DVD player or VTR player and therefore meets the limitation of receiving operation information. Furthermore, the operation information (i201-i210 received by the DVD player or VTR player or the like is implemented, such as, power on, play, stop, etc.),

wherein the shifting history represents a list of buttons depressed by the cursor
(As discussed above, the system of Saito et al. meets the claimed shifting history. Each

user selection is a button that a user has highlighted (meeting claimed "cursor") and selected (meeting claimed "depressed").

Regarding claim 6, Saito teaches that the control device is a TV (Col. 37, lines 3-15) and that the controlled device is a videocassette recorder (col. 34, lines 35-44).

Regarding claim 7, Saito teaches that similar to the VCR and the DVD player, the system has the ability to connect to a digital album server (col. 32, lines 25-32).

Regarding claims 8, 11 and 12, Saito teaches the claimed wherein the communication unit communicates with the controlled device via a serial bus conformed to IEEE 1394 protocol (Fig. 27, col. 32, lines 33-58, col. 32, lines 15-24).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gelek Topgyal whose telephone number is 571-272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GT
1/3/2008


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